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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,983	01/17/2002	John F. Carver	1823.0440001	3238

26111 7590 08/19/2003

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

JEFFERY, JOHN A

ART UNIT	PAPER NUMBER
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3742

DATE MAILED: 08/19/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,983

Applicant(s)

CARVER ET AL.

Examiner

John A. Jeffery

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 and 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *See Continuation Sheet*.

Continuation of Attachment(s) 6). Other: English translation of SU1769854.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 13 is rejected under 35 USC 102(b) as being anticipated by JP1-205392 or 3-161884. In Fig. 2, JP1-205392 discloses an electro-optical biometric image capturing system including a prism 11 and an infrared heater 20 disposed outside the optical path. The optical path is defined by the dashed line extending from (1) source 13, to (2) finger 12, and to (3) camera 14. Similarly, the claim is fully met by 3-161884 who discloses an electro-optical biometric image capturing system with heaters 21 (Fig. 2) and 16 (Fig. 3) that are both outside the optical path as shown in Figs. 4 and 5.

Claims 13, 16-18, and 20 are rejected under 35 USC 102(b) as being anticipated by SU1769854 (see English translation attached to this office action). SU1769854 discloses an electro-optical biometric image capturing system comprising first and second heater assemblies 7 coupled to opposite ends of prism 1 so that the prism's temperature is controlled responsive to temperature sensor 6 by temperature regulator 8. During operation, the user's finger is placed on liquid crystal film 5 disposed on glass plate 3. According to the certified English language translation, the fingerprint image is obtained "through port 4 with the aid of photo, video, or other technique...." thus

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establishing a light path through glass plates 3 and 4. (emphasis added.) See Translation, Page 2. Thus, the heaters 7 are disposed outside of the light path and on first and second ends of the prism as claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over SU1769854 in view of Maase (US5825474). The claims differ from SU1769854 in calling for a silicone pad. Using silicone as a platen material in an electro-optical biometric image capturing system is conventional and well known in the art as evidenced by Maase (US5825474) noting col. 4, lines 29-33 in which silicone is disclosed as a possible protective surface. In view of Maase (US5825474), it would have been obvious to one of ordinary skill in the art to use silicone as part of the finger-receiving surface of the previously described apparatus so that the finger-receiving platen was better protected with a silicone layer. Regarding claim 19, no criticality is seen in the specific heating control paradigm of three discrete power levels in view of Applicant's own admission in the instant specification on Page 13, paragraph 55 that other thresholds could be used or even eliminated entirely.

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Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over SU1769854 in view of JP1-205392. The claim differs from SU1769854 in calling for the heating element to be a resistive heating element. But resistive heating elements for heating prisms in finger imaging systems are well known in the art as evidenced by JP1-205392, noting electric heater 15 in Fig. 1. In view of JP1-205392, it would have been obvious to one of ordinary skill in the art to provide a resistive heating element for the heaters of SU1769854 in order to use a relatively inexpensive, easily controllable, and readily available source of heat for the prism.

Response to Arguments

Applicant's arguments filed 7/11/03 have been considered but are deemed to be moot in view of the new grounds of rejection.

Conclusion

Any inquiry concerning this or earlier communications from the examiner should be directed to John A. Jeffery at telephone number (703) 306-4601 or fax (703) 305-3463. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 4:30 PM EST. The examiner can also be reached on alternate Fridays.

The fax phone numbers for the organization where this application or proceeding is assigned are:

Before Final	(703) 872-9302
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After Final	(703) 872-9303
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Application/Control Number: 10/047,983

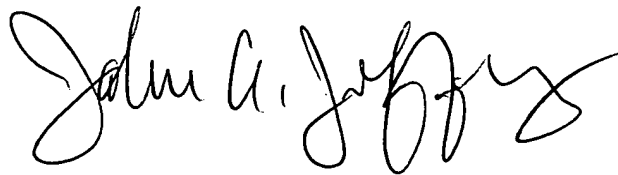
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Customer Service

(703) 872-9301

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0861.

A handwritten signature in black ink, appearing to read "John A. Jeffery". The signature is fluid and cursive, with a large initial "J" and a stylized "A".

**JOHN A. JEFFERY
PRIMARY EXAMINER**

8/14/03